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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,453	03/25/2004	Hiroyuki Kurihara	M1071.1906 - 516-0166/MG	4845
7590 11/29/2004			EXAMINER	
DICKSTEIN SHAPIRO MORIN & OSHINSKY, LLP 1177 Avenue of the Americas New York, NY 10036			KOPEC, MARK T	
			ART UNIT	PAPER NUMBER
			1751	
DATE MAILED: 11/29/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/808,453

**Applicant(s)**

KURIHARA ET AL.

**Examiner**

Mark Kopec

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 10/079,094.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

This application is a DIV of S.N. 10/079,094 (filed 2/19/02, now ABN). Claims 1-19 are currently pending.

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 10/079,094, filed on 2/19/02.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5, 6, 8 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 depends from itself (claim 5). Correction is required. Claims 5, 6, 8, and 14 have not been further treated on the merits. Applicant is advised that should claim 3 be found allowable, claim 7 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the

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other as being a substantial duplicate of the allowed claim.

See MPEP § 706.03(k).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for

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establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-4, 7, 9-14 and 16-19 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over either JP 04-146975 or JP 04-308605.

Note that full English language translations of the references have been ordered and will be provided to applicant as soon as possible.

JP '975 discloses a conductive paste composition produced by compounding synthetic resin, copper powder, higher fatty acid, and amine or nitrogen heterocycle (quinoline) (Abstract).

JP '605 discloses a copper paste composed of copper powder, glass frit, vehicle and metal oxide particle. The paste additionally contains benzotriazole (Abstract).

The references are anticipatory.

In the event that any minor modifications are necessary to meet the claimed limitations, such as selection of a particular resin vehicle or thickness of printed paste, such modifications are well within the purview of the skilled artisan.

Claims 1, 3, 4, 7, 10-13 and 16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yamaguchi et al (4,921,623).

Yamaguchi discloses copper-type conductive coating composition which comprises: (A) a copper powder, (B) a coating binder resin, and (C) at least one number selected from the group consisting of salicylic acid, its specific derivatives, and benzotriazolecarboxylic acid hydrazides. The copper-type conductive coating composition provides a conductive coating

layer having excellent initial conductivity and capable of maintaining the level of it stable over a long period of the time (Abstract; Col 2, formula III). A conductive coating composition comprises conductive filler powder dispersed in a solution of a thermoplastic resin or thermosetting resin, and it is useful for many purposes, for instance, as a paste for electric circuits, a conductive ink, a conductive adhesive or an electromagnetic wave shielding material (Col 1, lines 11-17). The reference additionally teaches cellulose resin vehicle (Col 3, lines 50-55), and examples 13-15 each specify various nitrogen-containing heterocycles (Col 10).

The reference is anticipatory.

In the event that any minor modifications are necessary to meet the claimed limitations, such as selection of a particular electronic component or thickness of printed paste, such modifications are well within the purview of the skilled artisan.

Claims 1-4, 7, 9-14 and 16-19 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Masuda.

Masuda discloses a multi-layer capacitor which can satisfy both of the X7R characteristic (EIA standard) and B characteristic (EIAJ standard) of the temperature characteristic

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of the electrostatic capacity, has little voltage dependency of the electrostatic capacity and the insulation resistance, is superior in insulation breakdown resistance, and can use Ni or a Ni alloy as the internal electrode layer (Abstract). For the internal electrode layer paste, 44.6 wt % of nickel particles of an average grain size of 0.4  $\mu\text{m}$ , 52.0 wt % of terpeneol, 3 wt % of ethyl cellulose, and 0.4 wt % of benzotriazole were kneaded using a triple-roll to make a paste. The above dielectric layer paste was used to form a green sheet of a thickness of 30  $\mu\text{m}$  on a PET film. The internal electrode paste was printed on this, then the green sheet was peeled from the PET film. The thus obtained green sheet was stacked and pressed to obtain a green chip. Four green sheets having the internal electrodes were stacked (Col 9, line 51 to Col 10, line 10).

The reference is anticipatory.

In the event that any minor modifications are necessary to meet the claimed limitations, such as selection of a particular electronic component or thickness of printed paste, such modifications are well within the purview of the skilled artisan.

In view of the foregoing, the above claims have failed to patentably distinguish over the applied art.




The remaining references listed on forms 892 and 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the rejection above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Kopec whose telephone number is (571) 272-1319. The examiner can normally be reached on Monday - Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Yogendra Gupta can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Mark Kopec  
Primary Examiner  
Art Unit 1751